UNITED STATES PATENT AND TRADEMARK OFFICE

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MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

EXAMINER
RAPILLO, KRISTINE K

ART UNIT	PAPER NUMBER
3626	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patent_docketing@intprop.com
ptomhkkg@gmail.com

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	10/045,649	MORIMOTO, NOBUYOSHI
	Examiner	Art Unit	
	KRISTINE K. RAPILLO	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/7/2011*.

2a)☐ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *7/14/2009* is/are: a)☒ accepted or b)☒ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>2/11/2002; 6/25/2002; 1/13/2003; 1/21/2003;</u>
<u>8/18/2003; 12/16/2003; 2/5/2004</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Notice to Applicant

1.   This communication is in response to the Amendment filed March 7, 2011. No claims are

amended. Claims 1 - 20 are pending.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1 – 2, 5, 7 – 8, 13 – 15 and 19 - 20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Harrell et al., herein after Harrell (U.S. Publication Number 2002/0156656 A1) in view

of www.pipinsure.com, herein after pipinsure

(http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html), further in view of

Welles et al., herein after Welles (U.S. Patent Number 5,686,888).

        In regard to claim 1 (Currently amended), Harrell teaches a method for arranging insurance for an

item to be shipped from an origination to a final destination, wherein the method comprises:

        Performing via one or more computers (Table 1):

        receiving a request, wherein the request is a request to insure the item during shipment from the

origination to the final destination (Figures 2 and 9; paragraphs [0005], [0031], [0041], and [0043]) where

high risk ports (destination) are taken into consideration when requesting and generating a quote for

insurance); generating a data file (Figure 1) comprising at least the following: item information including

one or more characteristics of the item (paragraph [0043]) where data is input regarding the commodity

(i.e. item) and Table 9 discloses various characteristics of the item, such as the type of commodity; and

insurer information indicating one or more terms of said particular insurance, the insurer information

specifying the insurer selected to provide said particular insurance during said shipment (Figures 2, 4,

and 5; paragraph [0048]; and, Tables 3, 4, 9, and 10) where the terms could reasonably include the

amount to insure the item.

Pipinsure teaches a method comprising searching a database to select particular insurance for

the item, according to one or more insurance criteria, wherein the particular insurance provides a

specified level of insurance coverage for the item during said shipment (page 2 and pages 8 - 9) where

the user may input information to obtain a quote of various insurance products based on criteria input by

user (i.e. insured value of package, products shipped).

Welles teaches a method comprising storing the data file in a memory device (column 2, lines 62

– 67 and column 3, lines 35 – 50); a memory device that accompanies an item during said shipment

(column 2, lines 62 – 67 and column 3, lines 35 – 50); accessing the memory device during or

subsequent to said shipment from the origination to the final destination (column 6, lines 24 – 42); and

Providing a notification to the insurer specified by the insurer information of said data file stored in the

memory device in regard to damage that occurred during said shipment (column 6, lines 24 – 42).

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Harrell in view of pipinsure,

further in view of Welles.

Harrell is directed to a method for selling marine cargo insurance in a network environment which

includes online quoting, billing, underwriting, and claims processing.

Pipinsure is directed to a parcel insurance plan to provide lower cost package insurance to

business shippers where a user may select a carrier from a list of multiple carriers.

Welles is directed to a method and system for monitoring the condition and integrity of goods in

transit using electronic sensors affixed to the container being shipped.

It would have been obvious to one of ordinary skill in the art to include in the online insurance

quoting system of Harrell the ability to provide lower cost shipping and insurance as taught by Pipinsure

and monitoring the shipment via sensors as taught by Welles since the claimed invention is merely a

combination of old elements, and in the combination each element merely would have performed the

same function as it did separately, and one of ordinary skill in the art would have recognized that the

results of the combination were predictable.

In regard to claim 2 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim

1.

Welles teaches a method wherein the memory device is configured to allow the data file to be

updated at any time before, during or after the shipment (column 6, lines 24 – 42) where any change to

the shipment is updated and tracked in real time.

The motivation to combine the teachings of Harrell, Pipinsure, and Welles is discussed in the

rejection of claim 1, and incorporated herein.

In regard to claim 3 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim

1.

Welles teaches a method further comprising packing the item in a container for shipping, wherein

the container is configured to fit with multiple other containers in a carrier (column 6, lines 4 – 23) where

Welles discloses attaching a sensor to each piece of cargo within a container.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the

invention was made to include a method further comprising packing the item in a container for shipping,

wherein the container is configured to fit with multiple other containers in a carrier with the motivation of

monitoring the condition and/or integrity of good being shipped (abstract).

In regard to claim 5 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim

1. Harrell teaches a method further comprising forwarding copies of the data file via the network to one or

more predetermined email addresses (paragraph [0041]).

In regard to claim 7 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim

1. Harrell teaches a method further comprising shipping the item using the least expensive routing

(Figure 2) where Harrell discloses modifications can determine the least expensive routing (i.e. lower premiums).

In regard to claim 8 (Previously Presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 1. Harrell further teaches a method wherein the data file further comprises contact information for at least one insurance companies that will provide said insurance (Figures 12 and 14) where Harrell discloses a reinsurer is notified in Figure 12, thus it is reasonable to conclude that the reinsurers contact information is available. In addition, Figure 14 illustrates contact of a claims representative and underwriter.

In regard to claim 13 (Previously Presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Welles teaches a method wherein the item information the data file further comprises item handling information (column 5, lines 50 – 61) where items requiring a specific temperature would require the specific temperature throughout transport, thus considered handling conditions.

The motivation to combine the teachings of Harrell, Pipinsure, and Welles is discussed in the rejection of claim 1, and incorporated herein.

In regard to claim 14 (Previously Presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 1. Harrell teaches a method wherein the item information the data file further comprises item content information (paragraph [0043]) where content is equated to commodity.

In regard to claim 15 (Currently Amended), Harrell, Pipinsure, and Welles teach the method as recited in claim 1. Harrell teaches a method wherein the insurer information in the data file further comprises one or more of: an insurance carrier that provides the particular insurance, an insurance policy number that identifies the particular insurance, an amount of insurance provided by the particular

insurance, and an insurance deductible for the particular insurance (paragraph [0043]) where the file

contains the amount insured (i.e. insurance information).

System and storage claims 19 and 20 repeat the subject matter of claims 1, 2, and 6. As the

underlying processes of claims 1, 2, and 6 have been shown to be fully disclosed by the teachings of

Harrell, Pipinsure, and Welles in the above rejections of claims 1, 2, and 6; as such, these limitations (19

and 20) are rejected for the same reasons given above for claims 1, 2, and 6 and incorporated herein.

4.   Claims 4, 6, 9 – 12 and 16 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Harrell (U.S. Publication Number 2002/0156656 A1) in view of www.pipinsure.com, herein after pipinsure

(http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html) and Welles et al.,

herein after Welles (U.S. Patent Number 5,686,888) as applied to claim 1 above, and further in view of

Bennett et al., herein after Bennett (U.S. Patent Number 7,117,170).

In regard to claim 4 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim

1.

Bennett teaches a method further comprising forwarding copies of at least a portion of the data

file via the network to one or more of the parties involved in the shipping, wherein the parties include at

least an originator of the request to ship the item, a recipient of the item at the final destination, and at

least one insurance company (Figures 26, 28, and 29; column 8, lines 41 – 57; column 12, lines 47 – 65;

and, column 13, lines 16 - 42) where Bennett discloses origin and destination (via zip codes) and

communicating this information over the internet.

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Harrell, Pipinsure, and

Welles in view of Bennett.

Harrell is directed to a method for selling marine cargo insurance in a network environment which

includes online quoting, billing, underwriting, and claims processing.

Pipinsure is directed to a parcel insurance plan to provide lower cost package insurance to business shippers where a user may select a carrier from a list of multiple carriers.

Welles is directed to a method and system for monitoring the condition and integrity of goods in transit using electronic sensors affixed to the container being shipped.

Bennett is directed to an apparatus system and method for electronically selecting a user's preferred method of shipping and billing by determining if the carriers meet the user's specifications.

It would have been obvious to one of ordinary skill in the art to include in the online insurance quoting system of Harrell the ability to provide lower cost shipping, insurance as taught by Pipinsure, monitoring the shipment via sensors as taught by Welles and electronically selecting the preferred method of shipping and carrier as taught by Bennett since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

In regard to claim 6 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method further comprising forwarding a copy of the data file via a network to a central server (column 8, lines 41 – 57; column 12, lines 47 – 65; and, column 13, lines 16 - 42) where a server has access to one or more databases.

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 9 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method further comprising storing the data file on a server connected to a network, wherein the server provides access to the data file via the network (column 8, lines 41 – 57; column 12, lines 47 – 65; and, column 13, lines 16 - 42).

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 10 (Previously Presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method wherein storing the data file comprises storing the data file in an XML format (Figures 66 and 67; column 11, lines 55 – 63; and column 55, lines 33 – 45).

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 11 (Previously presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 9.

Bennett teaches a method wherein the network data is exchanged in an XML format (Figures 66 and 67; column 11, lines 55 – 63; and column 55, lines 33 – 45).

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 12 (Previously Presented), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method wherein the item information data file further comprises item weight information (Figures 29 and 39a; column 20, line 65 through column 21, line 1).

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 16 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method wherein the data file further comprises one or more digital images of the item before, during, or after shipping (column 28, line 60 through column 29, line 10).

The motivation to combine the teachings of Harrell, Pipinsure, Welles, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

In regard to claim 17 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Bennett teaches a method wherein the data file further comprises one or more digital images of the item showing the physical condition of the item upon receipt (column 48, lines 43 – 57).

The motivation to combine the teachings of Harrell, Pipinsure, Keuper, and Bennett is discussed in the rejection of claim 4, and incorporated herein.

5.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrell in view of www.pipinsure.com, herein after pipinsure (http://web.archive.org/web/20000619183651/http://www.pipinsure.com/welcome.html) and Welles et al., herein after Welles (U.S. Patent Number 5,686,888) as applied to claim 1 above, and further in view of Kepler (U.S. Patent Number 5,347,845).

In regard to claim 18 (Original), Harrell, Pipinsure, and Welles teach the method as recited in claim 1.

Kepler teaches a method wherein the memory device comprises an air testing device configured to test air samples for contaminants and to store test results in the data file (column 2, lines 25 - 35).

Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over Harrell, Pipinsure, and Welles in view of Kepler.

online insurance quoting system of Harrell the ability to provide lower cost shipping and insurance as taught Harrell is directed to a method for selling marine cargo insurance in a network environment which includes online quoting, billing, underwriting, and claims processing.

Pipinsure is directed to a parcel insurance plan to provide lower cost package insurance to business shippers where a user may select a carrier from a list of multiple carriers.

Welles is directed to a method and system for monitoring the condition and integrity of goods in transit using electronic sensors affixed to the container being shipped.

Kepler is directed to a system for sampling air in a shipping container via a sensor.

It would have been obvious to one of ordinary skill in the art to include in the online insurance quoting system of Harrell the ability to provide lower cost shipping, insurance as taught by Pipinsure, monitoring the shipment via sensors as taught by Welles and monitoring the air via a sensor as taught by Kepler since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Response to Arguments

6.   Applicant's arguments filed April 7, 2010 have been fully considered but they are not persuasive. The Applicant's arguments will be addressed in the order in which they were presented.

35 U.S.C. 103(a) Rejections

Claim 1 – Harrell in view of Pipinsure in further view of Welles

1)   The Applicant argues the cited art fails to teach or suggest the generation of the specific type of data file claimed and the inclusion of such a data file within a memory device that accompanies an item during shipment.

The Applicant argues the cited art fails to teach or suggest i) generating a data file comprising at least the following information including one or more characteristics of the item, and insurer information indicating one or more terms of said particular insurance, the insurer information specifying the insurer

selected to provide said particular insurance during said shipment and ii) storing the data file in a memory device that accompanies the item during shipment. The Examiner respectfully disagrees. With regard to *generating a data file,* Harrell discloses completing data entry requirements and downloading a customer profile (Table 1 and paragraph 126). It is suggested that downloading a customer profile will generate a data file containing customer information. The *item information including one or more characteristics of the item,* as claimed by the Applicant, is shown where the data is input regarding the commodity (i.e. item); Table 9 of Harrell discloses that the information would include the type of commodity to be shipped and characteristics (i.e. is the item to be containerized). The *insurer information indicating one or more terms of said particular insurance* is disclosed where Harrell teaches a system is which a quote is displayed containing quote information such as premium, deductible, currency, terms, and conditions (Figure 2). The terms and conditions of the contract (i.e. insurance) are provided to the user for review (paragraph 48).

New prior art (Welles) has been applied to the limitation store the data file in the memory device that accompanies the item during said shipment. The Examiner submits that is irrelevant what type of data is being stored; Welles is cited for storing data (i.e. serial number). The fact that Welles stores a serial number (data) implies that other data may be stored also. Thus, the Applicant's argument is not persuasive.

2)   *The Applicant argues the cited art fails to teach or suggest searching a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage for the item during said shipment.*

The Applicant argues that the cited art fails to teach or suggest searching a database to select particular insurance for the item according to one or more insurance criteria, wherein the particular insurance provides a specified level of insurance coverage during said shipment. The Examiner respectfully disagrees. Pipinsure provides a user the ability to enter shipping needs, value of items to be shipped and coverage desired (pages 8 and 10) all of which suggest a particular insurance for shipment of an item. In addition, Pipinsure utilizes a broker for handling policy changes (page 23) suggesting the

availability of different policies. In addition, the claims fail to specify that the insurer must be separate

from the shipper or carrier.

3)   The Applicant argues the cited art fails to teach or suggest accessing the memory device during

or subsequent to said shipment from the origination to the final destination, and providing a notification to

the insurer specified by the insurer information of said data file stored in the memory device in regard to

damage that occurred during said shipment.

The Applicant argues the cited art fails to teach or suggest accessing the memory device during

or subsequent to said shipment from the origination to the final destination, and providing a notification to

the insurer specified by the insurer information of said data file stored in the memory device in regard to

damage that occurred during said shipment. The Examiner respectfully disagrees. The Examiner

submits Welles discloses a mode of operation might be to monitor all transmitted temperature signals. If

any temperature rises or falls below the threshold supplied by the customer, an immediate or scheduled

report is made (column 6, lines 24 – 42), thus implying access to the device since an immediate report

can be made. The Welles reference (column 6, lines 24 – 42) also implies that notification of any damage

occurring during shipment is provided where the temperature fluctuations disclosed by Welles illustrate

potential damage to cargo and that the report provided may be available immediately. Thus, the

Applicant's argument is not persuasive.

4)   The Applicant argues the Office Action failed to provide a clear articulated reasoning with rational

underpinning to support a prima facie case of obviousness.

In response to applicant's argument that there is no suggestion to combine the references and

that the Office has not made a prima facie case of obviousness, the examiner recognizes that

obviousness can only be established by combining or modifying the teachings of the prior art to produce

the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re*

Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941

(Fed. Cir. 1992). In this case, it has been clearly set forth above in the 35 U.S.C. 103(a) rejections of the

claims that there is motivation for combining the references (Harrell and Pipinsure in view of Welles) and

therefore the Office takes the position that a prima facie case of obviousness has been made.

5)   The Applicant argues combining the references in the manner suggested by the Office would not

result in the Applicant's claimed invention.

In response to applicant's argument that there is no suggestion to combine the references and

that the Office has not made a prima facie case of obviousness, the examiner recognizes that

obviousness can only be established by combining or modifying the teachings of the prior art to produce

the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re*

Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941

(Fed. Cir. 1992). In this case, it has been clearly set forth above in the 35 U.S.C. 103(a) rejections of the

claims that there is motivation for combining the references (Harrell and Pipinsure in view of Welles) and

therefore the Office takes the position that a prima facie case of obviousness has been made.

The Examiner respectfully submits that the Harrell is directed to a method for selling marine cargo

insurance in a network environment which includes online quoting, billing, underwriting, and claims

processing (Abstract); Pipinsure is directed to a parcel insurance plan to provide lower cost package

insurance to business shippers where a user may select a carrier from a list of multiple carriers (Page 2);

and, Welles is directed to a method and system for monitoring the condition and integrity of goods in

transit using electronic sensors affixed to the container being shipped (Abstract). In addition, the key to

supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed

invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a

rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn*, 441 F.3d 977, 988,

78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "[R]ejections on obviousness cannot be sustained by

mere conclusory statements; instead, there must be some articulated reasoning with some rational

underpinning to support the legal conclusion of obviousness.'" *KSR*, 550 U.S. at ___, 82 USPQ2d at

1396. An example of rationale that may support a conclusion of obviousness include: (G) Some teaching,

suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art

reference or to combine prior art reference teachings to arrive at the claimed invention See MPEP §

2143. Furthermore, if the search of the prior art and the resolution of the *Graham* factual inquiries reveal

that an obviousness rejection may be made using the familiar teaching-suggestion-motivation (TSM)

rationale, then such a rejection should be made. Although the Supreme Court in *KSR* cautioned against

an overly rigid application of TSM, it also recognized that <u>TSM was one of a number of valid rationales</u>

<u>that could be used to determine obviousness</u>. (According to the Supreme Court, establishment of the

TSM approach to the question of obviousness "captured a helpful insight." 550 U.S. at ___, 82 USPQ2d

at 1396 (citing *In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ 206, 207-208 (1961)).

6)   The Applicant argues the Pipinsure reference has not been shown to be prior art to the present

application.

        The Applicant argues the Pipinsure reference has not been shown to be prior art to the present

application. The Applicant adds http://www.archive.org does not guarantee the accuracy of its

collections, Applicant asserts that it is not proper to rely on http://www.archive.org to establish a

publication date. The Examiner respectfully disagrees. The Office holds the position that a web site is

considered proper prior art (see MPEP section 2128, Electronic Publications as Prior Art).

Claim 1 – Harrell in view of Pipinsure in view of Welles further in view of Bennett

1)   The Applicant argues Bennett fails to overcome the deficiencies of Harrell, Pipinsure, and Welles

as noted on page 7 of the Office Action mailed December 7, 2010. The Examiner respectfully submits

that Claim 4 was rejected on page 7 of the Office Action mailed December 7, 2010, not claim 1. The

Examiner respectfully submits Bennett is directed to an apparatus, system, and method of electronically

selecting a user's preferred method of shipping and billing by determining if the carriers meet the user's

specification (Abstract).

Claim 1 – Harrell in view of Pipinsure in view of Welles further in view of Keplar

1)   The Applicant argues Bennett fails to overcome the deficiencies of Harrell, Pipinsure, and Welles

as noted on page 12 of the Office Action mailed December 7, 2010. The Examiner respectfully submits

that Claim 18 was rejected on page 12 of the Office Action mailed December 7, 2010, not claim 1. The

Examiner respectfully submits Keplar is directed to a system for sampling air in a shipping container being

shipped (Abstract).

Claims 19 and 20

The Applicant argues the Examiner failed to state a prima facie rejection of claims 19 and 20

because the office action failed to address specific limitations of claims 19 and 20. The Examiner

respectfully disagrees and submits Pipinsure provides a data field in which a user may input the highest

insured value of any package when requesting a quote for package insurance (page 8), thus the highest

insured value is equated to a maximum coverage. Therefore, Applicant's argument is not persuasive.

Conclusion

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth

in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from

the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date

of this final action and the advisory action is not mailed until after the end of the THREE-MONTH

shortened statutory period, then the shortened statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX

MONTHS from the mailing date of this final action.

8.   Any inquiry concerning this communication or earlier communications from the examiner should

be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can

normally be reached on Monday to Thursday 6:30 am to 3:30 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Robert Morgan can be reached on 571-272-6773. The fax phone number for the organization where this

application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application

Information Retrieval (PAIR) system. Status information for published applications may be obtained from

either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC)

at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative

or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-

1000.

/K. K. R./
Examiner, Art Unit 3626

/Dilek B Cobanoglu/
Primary Examiner, Art Unit 3626